

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 3, 5, 6, 9, and 11-14 are presently active in this case, Claims 3, 5, 9, 11, and 12 having been amended, Claims 1, 2, 4, 7, 8, and 10 having been canceled without prejudice or disclaimer, and Claims 13 and 14 having been added by way of the present Amendment.

In the outstanding Official Action, Claims 1 and 7 were rejected under 35 U.S.C. 102(b) as being anticipated by Kumar et al. (U.S. Patent No. 5,880,924). Claims 1-3 and 7-9 were rejected under 35 U.S.C. 102(b) as being anticipated by Hirose (U.S. Patent No. 6,878,233). Claims 4-6 and 10-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose in view of del Puerto et al. (U.S. Patent No. 6,778,258). Claims 2, 3, 8, and 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar et al. in view of Poli et al. (U.S. Patent No. 5,280,979). Claims 4-6 and 10-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar et al. in view of Poli et al. and del Puerto et al. For the reasons discussed below, the Applicants request the withdrawal of the art rejections.

Regarding the Hirose reference, the Applicants note that since the PCT application for the Hirose reference was filed after November 29, 2000, the new version of 35 U.S.C. 102(e) applies. Thus, in order for the PCT filing date to be considered as a 102(e) date, then two requirements must be met: (1) the PCT application must have designated the United States; and (2) the PCT publication on January 31, 2002, must have been in English. If either of these requirements is not met, then the PCT application would not have a 102(e) date. (See MPEP 706.02(f)(1) Example 5.) Since it appears that WO 02/09172 was published in Japanese, rather than in English, then it appears that the PCT application does not have a

102(e) date under the new version of this section. Thus, it appears that a rejection using the Hirose reference under 35 U.S.C. 102(e) is improper.

Furthermore, in order to remove the publication of the Hirose reference on January 31, 2002, as a prior art reference with respect to the present application, the Applicants are submitting concurrently herewith an English translation of the Japanese priority document (JAPAN 2002-014559). Thus, the Applicants submit that priority has been perfected, and therefore the Hirose reference is not prior art with respect to the present application. Accordingly, the Applicants request the withdrawal of all of the anticipation and obviousness rejections that cite the Hirose reference.

Furthermore, the Applicants note that the subject matter of original Claims 1 and 4 have been incorporated into pending independent Claim 3, and the subject matter of original Claims 1, 7, and 10 have been incorporated into pending independent Claim 9. Thus, the Applicants submit that the anticipation rejection based on the Kumar et al. reference has been overcome, and that the obviousness rejection based on the Kumar et al. reference in view of the Poli et al. reference has been overcome. Thus, the sole remaining rejection is the obviousness rejection based on the Kumar et al. reference in view of the Poli et al. reference and the del Puerto et al. reference, which is addressed below.

The basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 include (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the reference (or references when combined) must teach or suggest all of the claim limitations. The Applicants submit that a *prima facie* case of obviousness has not been established in the present case because the references, either when

taken singularly or in combination, do not teach or suggest all of the limitations recited in independent Claims 3 and 9.

Claim 3 of the present application recites a charge eliminating mechanism comprising a grounded wiring line having a first end and a second end, the second end being grounded; and a mechanical switching mechanism arranged between the stage and the first end of the wiring line, wherein the mechanical switching mechanism of the charge eliminating mechanism comprises a contact terminal including a contact terminal main body, a third end, and a fourth end, the fourth end being electrically connected to the first end of the wiring line, and a contact state between the third end and the stage being physically turning on/off, and when the third end is in contact with the stage, the stage is grounded through the third end of the contact terminal, the contact terminal main body, the fourth end, the first end of the wiring line, a resistor, and the second end of the wiring line, and wherein at least one of the contact terminal and the stage includes an elastic contact mechanism to cause the third end of the contact terminal and the stage to come into elastic contact with each other. Claim 9 recites a testing apparatus comprising a charge eliminating mechanism comprising, among other features a contact terminal having a contact terminal main body, a third end, and a fourth end, the fourth end being electrically connected to the first end of the wiring line, and a contact state of the third end with respect to the stage being physically turned on/off, and when the third end is in contact with the stage, the stage is grounded through the third end of the contact terminal, the contact terminal main body, the fourth end, the first end of the wiring line, a resistor, and the second end of the wiring line.

The Kumar et al. reference is cited for the teaching of a discharge electrode (85) and a switching circuit (165), which are cited as being a charge eliminating mechanism of the present invention. The switching circuit (165) is electrically connected to the discharge

electrode (85) and includes a switch for connecting the electrode to electrical ground or for supplying a voltage or opposing electrical potential that depletes or neutralizes the residual electrostatic charge on the substrate (12). The switching circuit (165) is described and depicted as a single pole, three position switch that selectively electrically connects the discharge electrode (85) to electrical ground, a dechucking voltage source (170) to accelerate dissipation of the accumulated charge, or a third “floating” position to which no potential is applied.

In order for the switching circuit (165) to disclose the switching mechanism of the present application, as is suggested in the Official Action, it would have to include a fourth end being electrically connected to the first end of the wiring line, and a third end where a contact state between the third end and the stage being physically turning on/off. As noted above and as depicted in Figure 4, the switching circuit (165) of the Kumar et al. reference has an end that is connected to a ground, which is cited for the “fourth end” of the present invention. The end of the switching circuit (165) that is connected to the ground is the middle contact position depicted in Figure 4 that is directly connected to the ground. Therefore, the switching circuit must also include a third end where a contact state between the third end and the stage being physically turning on/off, in order to disclose the switching mechanism of the present application. However, the other end of the switching circuit (165) of the Kumar et al. reference is always connected to the discharge electrode (85). As is evident from Figure 4, the single pole of the switching circuit (165) with the arrow pointed directly thereto is always in contact with the discharge electrode (85), and therefore this end of the switching circuit (165) does not have a contact state between said end and the stage being physically turning on/off, since this end cannot move out of contact with the stage to turn off the switch. To the contrary, the present application describes a non-limiting

embodiment in which a third end (21(2)) of a switch (40) moves into and out of contact with the stage in order to turn on and off the charge elimination mechanism. The Kumar et al. reference instead provides the fourth end thereof that is not always in contact with the discharge electrode, but rather with a contact state therebetween that turns on and off the grounding function, and such a configuration is specifically provided in order to also provide switching connection to a discharge voltage supply (170).

Thus, the Kumar et al. reference does not disclose all of the features of the switching mechanism of the present invention as recited in Claims 3 and 9. Furthermore, the modification or combination of the switching circuit (165) of the Kumar et al. reference to include the third end as defined in Claims 3 and 9 of the present application would be contrary to the teaching in the Kumar et al. reference, which specifically includes the switching circuit (165) as a single pole, three position switch that allows for selective electrical connection between not only the discharge electrode (85) and an electrical ground or a “floating” position to which no potential is applied, but also allows for the discharge electrode (85) to be connected to a dechucking voltage source (170) to accelerate dissipation of the accumulated charge (see column 7, lines 37-57, of the Kumar et al. reference). Thus, to modify or combine such a configuration in order to arrive at the claimed mechanical switching mechanism would be directly contrary to the teachings of the Kumar et al. reference.

Furthermore, the Official Action cites the Poli et al. for the teaching of a resistor and combines this teaching with the teachings of the Kumar et al. reference and the del Puerto et al. reference. However, the Applicants submit that such a combination is contrary to the teachings of the primary reference, i.e. the Kumar et al. reference. The Official Action indicates that “[i]t would have been obvious to those skilled in the art at the time the

invention was made to modify Kumar's charge eliminating mechanism to include a resistor in the wiring line as taught by Poli, because resistor protect the circuits on the work-to-be processed from damage due to rapid discharge of electrostatic charge." However, the Kumar et al. reference actually teaches a feature that is used to *increase* dissipation of the charge, rather than slow the discharge down. The Kumar et al. reference specifically includes a "dechucking voltage source 170 to accelerate dissipation of the accumulated charge." (Column 7, lines 51-53.) Thus, such a combination would not have been obvious to one of ordinary skill in the art based on the combined teachings of the Kumar et al. and Poli et al. references.

Accordingly, the Applicants submit that a *prima facie* case of obviousness has not been established with respect to pending independent Claims 3 and 9. Thus, the Applicants respectfully request the withdrawal of the obviousness rejection based on the combination of the Kumar et al., Poli et al., and del Puerto et al. references.

The dependent claims are considered allowable for the reasons advanced for the independent claim from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed nor suggested by the applied references when those features are considered within the context of their respective independent claim.

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Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

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